

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

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PCT

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL PRELIMINARY
EXAMINATION REPORT

(PCT Rule 71.1)

Date of mailing
(day/month/year)

04.01.2005

Applicant's or agent's file reference
L0532.70027W000

IMPORTANT NOTIFICATION

International application No.
PCTUS 03/1877

International filing date (day/month/year)
08.10.2003

Priority date (day/month/year)
18.10.2002

Applicant
VERIFICATION TECHNOLOGIES, INC. et al.

DOCKETED

JAN 10 2005

Initials

Confirmation ☐

Docketing ☒

[Signature]

314105

NPF

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international
preliminary examining authority:



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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)



Applicant's or agent's file reference L0532.70027	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/US 03/31877	International filing date (day/month/year) 08.10.2003	Priority date (day/month/year) 18.10.2002
International Patent Classification (IPC) or both national classification and IPC G06K7/12		
Applicant VERIFICATION TECHNOLOGIES, INC. et al.		

- This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
- This REPORT consists of a total of 6 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of sheets.

- This report contains indications relating to the following items:
 - ☒ Basis of the opinion
 - ☐ Priority
 - ☒ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - ☐ Lack of unity of invention
 - ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - ☐ Certain documents cited
 - ☐ Certain defects in the international application
 - ☐ Certain observations on the international application

Date of submission of the demand 18.05.2004	Date of completion of this report 04.01.2005
Name and mailing address of the international preliminary examining authority:  European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016	Authorized Officer Verdoodt, E Telephone No. +31 70 340-3577 

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/US 03/1877

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-31 as originally filed

Claims, Numbers

1-48 as originally filed

Drawings, Sheets

1/6-6/6 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/US 03/31877

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application,

☒ claims Nos. 34

because:

☒ the said international application, or the said claims Nos. 34 relate to the following subject matter which does not require an international preliminary examination (specify):

see separate sheet

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.

☐ no international search report has been established for the said claims Nos.

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

☐ the written form has not been furnished or does not comply with the Standard.

☐ the computer readable form has not been furnished or does not comply with the Standard.

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	21,23,28,30,46-48
	No: Claims	1-20,22,24-27,29,31-33,35-45
Inventive step (IS)	Yes: Claims	
	No: Claims	1-33,35-48
Industrial applicability (IA)	Yes: Claims	1-33,35-48
	No: Claims	34

2. Citations and explanations

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

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see separate sheet

Re Item III

Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

Claim 34 relates to subject-matter considered by this Authority to be covered by the provisions of Rule 67.1(iii) PCT, i.e. methods of doing business. Consequently, no opinion will be formulated with respect to the industrial applicability of the subject-matter of these claims (Article 34(4)(a)(I) PCT).

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following documents:

- D1: WO 01/06453 A (VERIFICATION TECHNOLOGIES INC) 25 January 2001 (2001-01-25)
- D2: US-B-6 203 0691 (LOOP ROBERT ET AL) 20 March 2001 (2001-03-20)
- D3: US-A-5 574 790 (SILVERGLATE DAVID ET AL) 12 November 1996 (1996-11-12)

1. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of **independent claims 1 and 31 is not new** in the sense of Article 33(2) PCT.
- 1.2 **Claim 1:** The document D1 discloses (the references in parentheses applying to this document):
A system for applying at least a portion of an authentication mark to a substrate and verifying the application of at least a portion of the mark on the substrate, the substrate being disposed on a production line (Page 35, lines 9-13), the system comprising:
 - an applicator (ink jet printer: page 35, line 9-10) locatable at the production line and configured and arranged to apply at least one light-sensitive compound (Page 23, lines 5-8) on the substrate to produce at least a portion of the authentication mark (identifying mark: page 35, line 10); and
 - a verification device (Page 35, line 12-13) locatable at the production line and configured and arranged to verify application of the at least one light-sensitive compound on the substrate.
- 1.3 The same reasoning applies, mutatis mutandis, to the subject-matter of the corresponding **independent claim 31**, which therefore is also considered not new.

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/US 03/31877

- 2.1 **Dependent claims 2-14, 16-30, 32, 33, 35-48** do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step, see documents D1, D2 and D3 and the corresponding passages cited in the search report.
- 2.2 With respect to **claim 21 and 23**, a controller communicating with the verification device and applicator or production line controller is not explicitly mentioned in D1. Yet, such a controller is merely obvious in order to take action upon the results of the verification device.
- 2.3 With respect to **claim 24, 28 and 30** reference is made to the passage in D1 on page 27, lines 10-20, where receptacles, adapted to interchangeably receive light sources, source (excitation) or emission filters are mentioned. To adapt these receptacles to receive excitation or emission lenses as in claim 28 or 30, is a straight forward design change.
- 3.1 The application does not meet the requirements of Article 6 PCT, because **claim 15** is not clear.
- 3.2 Claim 15 seeks to define a relationship to another entity, the substrate, which is not part of the system itself. In fact, the substrate undergoes the application and verification by the system.
- 3.3 Furthermore, the above-mentioned lack of clarity notwithstanding, claim 15 is not new in the sense of Article 33(2) PCT, when D1 is considered.